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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/425,636	10/22/99	QUONG D	55197USA4A

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EXAMINER	
NGUYEN,H	
ART UNIT	PAPER NUMBER
1617	6

DATE MAILED: 05/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary	Application No.	Applicant(s)	
	09/425,636	QUONG, DOUGLAS	
	Examiner	Art Unit	
	Helen Nguyen	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20 February 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-32* is/are pending in the application.

4a) Of the above claim(s) *9 and 19-32* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8 and 10-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2* .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

DETAILED ACTION

Applicant's election with traverse of Group I, claims 1-18. In addition, Applicants elected alginates specie in claim 8, and pheromone specie in claim 10, in Paper No. 5 is acknowledged. The traversal is on the ground(s) that both composition and method claims are related inventions and the search for species would not place an additional burden on the Examiner. This is not found persuasive because the record set forth in the previous restriction requirement clearly indicates that the delineated inventions are, in fact, patentably distinct, each from the other, and their different classification would necessitate additional searching. In addition, this application contains claims directed to the patentably distinct species of the claimed invention as set forth in the previous restriction requirement. The search of these species claims would place an additional burden on the examiner.

The requirement is still deemed proper and is therefore made FINAL.

As to the record set forth in the previous restriction and the species requirement, Applicant has over looked the election over claims 7-9. Therefore, a telephone call was made to Mr. Dale A. Bjorkman on Thursday April 26, 2001 to confirm that Applicant either elect over claims 7-9 and the election of an ultimate specie upon the elected claim. Applicant elected the alginate specie in claim 8.

Claims 9 and 19-32 are non-elected.

Claims 1-8 and 10-18 are presented for examination.

Claim rejection

The following is a quotation of the **first paragraph of 35 U.S.C. 112**:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims1-8 and 10-18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for methods of entraining and microbead formation simultaneously, does not reasonably provide enablement for a method comprising microbead formation followed by entraining. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Applicant discloses the above cited methods on page 15, lines 9-15. No other method is disclosed.

Scope

Claims 1-8, 10-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Nowhere in the specification is the solute disclosed.

enablement

Claims 13-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Nowhere in the specification is the method of placing the claimed ingredients in the microbead disclosed.

enablement

Claims 1-8 and 10-18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for water as a solvent, does not reasonably

Scope

provide enablement for any solvent. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. On page 20, line 26, water is disclosed. No other solvent is specified.

The following is a quotation of the **second paragraph of 35 U.S.C. 112**:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 and 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the method steps are vague. Applicant teaches steps (a) and (b) are the methods of making the product while steps (c) and (d) are the method of delivering the product. It is unclear as to whether Applicants claim a method of making or a method of using.

In claim 1, the term "entraining" is vague. How entraining?

In claim 1, the term "substrate" is vague. What substrate?

In claims 1 and 4, the term "solution" is vague. What is the solute? Does Applicant refer to the same solution in claim 4 as in claim 1?

In claim 5, the phrase "ambient air" is vague. Does Applicant intend a certain temperature and air quality?

In claim 6, the phrase "repeated sequentially" is vague. How many times?

The following is a quotation of **35 U.S.C. 103(a)** which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8, 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Connick Jr. (US Patent No. 4,400,391) and Nesbitt et al. (US Patent No. 4,487,759).

Connick Jr. teaches alginate gel beads containing pheromones. See abstract and column 3, lines 23-27. The beads provide controlled release of active agent, wherein the active agent is a pheromone. See column 2, lines 41-43. The beads may be prepared by spraying into a gellant bath. See column 2, lines 48-50. The beads can dry to any desired moisture content without losing their effectiveness. See column 2, lines 30-32. The concentration of the active is 0.1-20% by weight. See column 4, lines 3-6. A bead diameter of 100 µm is disclosed. See column 2, lines 47-48. Other ingredients or additives such as a surfactant and starch (an oil absorbent according to applicant, see page ~~8~~ 12, line ~~8~~ 5) can be added. See column 5, lines 8-18.

Connick Jr. does not teach applicant's method of delivery and additives.

Nesbit teaches a microcapsule containing pheromones. See column 2, lines 6-7. The diameter of the microcapsule is 100 µm, and the product takes the form of a suspension of micro-capsules in a continuous aqueous phase, so that the suspension can be applied by spraying. See column 2, lines 1-4. Nesbit teaches a slow release of the active compound. See column 2, lines13-15. Further, Nesbit teaches the inclusion of additives such as antioxidants, UV protectants and stabilizers. See column 7, lines 36-

39 and column 8, lines 26-28. Nesbit teaches spraying onto crops for pest control. See column 8, line 66 bridging column 9, line 4.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add additives to the composition of Connick Jr. to achieve the beneficial effect of preventing photodegradation in view of Nesbit. Further, it would be obvious to use a spray formulation of the suspended particles of Connick Jr. (as discussed above) to obtain the beneficial effect of pest control in view of Nesbit.

As to the claimed dehydration and rehydration, Nesbit teaches spraying the composition into the environment, which has natural changes in humidity, and therefore would cause the composition to naturally dehydrate and rehydrate, as the levels of humidity in the environment change regularly. Further, applicant has not shown that the means by which the humidity is formed is critical, and therefore the natural environment moisture produced through humid air and rain reads on applicant's claims.

Repeat

❖ A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1-8 and 10-18 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7, 9-22 and 25-27 of copending Application No.

filed 10/22/99

09/425,761. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

❖ The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

filed 10/22/99

Claims 1-8 and 10-18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-50 of copending Application No. 09/426,140. Although the conflicting claims are not identical, they are not patentably distinct from each other because those of '140 encompass the instant claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-8, 10-18 are rejected.

Claims 9 and 19-32 are non-elected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helen Nguyen whose telephone number is (703) 605-1198. The examiner can normally be reached on M-F (9:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Minna Moezie can be reached on (703) 308-4612. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 305-3592 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Helen Nguyen
Patent Examiner

May 4, 2001

EDWARD J. WEBMAN
PRIMARY EXAMINER
GROUP 1500